

Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

### REMARKS

Claims 1-6 are pending in the present application. Claims 1-6 stand rejected according to the Office Action dated May 11, 2005.

### REJECTIONS UNDER 35 USC § 103(a)

Claims 1-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over German Application DE 4136540 A1 to Pegaz (hereafter "Pegaz") in view of U.S. Patent No. 5,695,868 to McCormack (hereafter "McCormack"). In support of the rejection, the Office states, "Pegaz discloses a disposable absorbent article which comprising [sic] an impermeable backsheet, a liquid absorbing core, and a liquid permeable topsheet, which contains a skin care composition." The Office acknowledges that Pegaz does not disclose the percentage of materials in the composition, but the Office asserts that Pegaz does teach "a skin care agent having components from the claimed groups of waxes, emollients, [sic] viscosity increasing agents." Therefore, the Office concludes, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Pegaz with the claimed percentage of materials in the skin care composition." In support of the conclusion The Office cites the following case law: "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 105 U.S.P.Q. 233 (CCPA 1955).

The Office further concedes that Pegaz does not teach a vapor permeable backsheet. The Office states that McCormack discloses "a breathable film/nonwoven composite suitable for use as an outer cover in absorbent articles." The Office concludes, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Pegaz with a vapor permeable backsheet having the claimed water vapor transmission rate for the benefits disclosed in McCormack." Applicant traverses this rejection for several reasons discussed below.

Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

The Office has stated that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Pegaz with the claimed percentage of materials in the skin care composition." Applicant refutes the Office's conclusion that one of ordinary skill in the art need only optimize concentration ranges to yield Applicant's claimed invention. The Office relies on case law to support its conclusion that "'where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.'" *In re Aller et al.*, 105 USPQ 233." *Aller* involved an applicant trying to claim a chemical process which differed in regard to concentration of a single compound (i.e., sulfuric acid) and the process temperature compared to the prior art. However, Pegaz requires far more than mere optimization of concentration.

First, one skilled in the art must determine which of the six broad categories of substances should be used. Pegaz lists the following six broad categories of substances: (1) lubricants, (2) hydrophobic substances, (3) pH lowering agents, (4) disinfecting agents, (5) bacteriostatic agents, and (6) substances which heal, alleviate, or sooth diaper dermatitis. Each of these categories may or may not be present in the diaper of Pegaz. Second, one skilled in the art must then select what individual species to use within the categories selected in the first step. Each of these six broad categories may encompass numerous individual substances. For example, Pegaz lists eighteen examples of healing agents. Given that any combination of the six categories may be present and that each category may contain numerous individual substances of which more than one may be present, there are potentially thousands of combinations that may be optimized. Third, only once the broad categories of substances have been chosen and the individual species within the broad categories have been chosen may one of ordinary skill in the art begin optimizing the concentrations. Clearly, more is required than mere optimization of ranges in order for Pegaz to teach each and every limitation of Applicant's claims.

Furthermore, it is clear that more than routine experimentation is necessary to result in Applicant's recited claims. Case law has held that "obvious to try" is not a valid test of patentability. *See In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987) ("one skilled in the art

Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. § 103.”). Pegaz does not teach a specific substance or combination of substances. Instead, Pegaz provides a list of possible categories – each of which includes a laundry list of possible species.

Applicant requests withdrawal of the rejection since the motivation for modifying Pegaz is erroneous. Pegaz requires more than optimization of ranges and requires more than routine experimentation in order to teach Applicant’s claimed invention.

With regard to Claim 2, the Office has failed to point to any passage within Pegaz which teaches or suggests Applicant’s limitation of a skin care composition further comprising a viscosity increasing agent. As a result, Applicant requests withdrawal of the rejection since the Office has failed to teach each and every limitation of the present claim.

With regard to the combination of Pegaz and McCormack, the Office states, “It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the article of Pegaz with a vapor permeable backsheet having the claimed water vapor transmission rate for the benefits disclosed in McCormack.” Applicant asserts that the Office has failed to provide a sufficient motivation for the proposed combination. First, case law has repeatedly stated that the prior art must provide the motivation to make the proposed modification. See *In re Deminski*, 796 F.2d 436, 443 (Fed. Cir. 1986) (“There was no suggestion in the prior art to provide Deminski with the motivation to design the valve assembly so that it would be removable as a unit.”); *In re Lahu*, 747 F.2d 703, 705, (Fed. Cir. 1984) (“The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.”); *In re Beattie*, 974 F.2d 1309, 1311-1312 (Fed. Cir. 1992)(quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984) (“When determining the patentability of a claimed invention which combines two known elements, “the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.”); *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438, 440 (B.P.A.I. 1984) (“The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant’s

Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

specification, to make the necessary changes in the reference device.”). The Office has failed to show how the prior art provides one of ordinary skill in the art with the motivation to make the proposed modification. Instead, the Office merely states the benefit of the proposed combination (i.e., “the article of Pegaz with a vapor permeable backsheet having the claimed water vapor transmission rate *for the benefits* disclosed in McCormack.”). The Office has pointed to nothing within the individual references that suggests the inclusion of the other reference.

In further regard to the combination of Pegaz and McCormack, it is well settled that the Office cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention bases on hindsight of Applicant’s invention. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986)(“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”). The Office states that it would be obvious “to provide the article of Pegaz with a vapor permeable backsheet having the claimed water vapor transmission rate for the benefits disclosed in McCormack.” Pegaz discloses a diaper comprising an outer liquid-impermeable layer. McCormack discloses a composite including “a film layer and a fibrous polyolefin nonwoven web comfort and support layer.” Col. 5, lines 41-42. From the background of McCormack, it is clear that the nonwoven web is the outermost layer (“Fibrous nonwoven webs when used as the backing material for diapers alleviate the above-mentioned film problems” – Col. 2, lines 5-6). The combination of the Pegaz and McCormack will result in a product having a nonwoven web as the outer layer. However, the Office has not specified whether the outer nonwoven layer is liquid impermeable. McCormack states that the composite will act “as a barrier to the passage of liquids” (Col. 5, lines 15-16), but McCormack does not teach that the outer nonwoven layer is impermeable to liquids. Applicant asserts that it is improper to combine references where the references teach away from their combination. Since Pegaz teaches a liquid impermeable outer layer and the outer layer taught by McCormack is not disclosed as being impermeable, it is unreasonable to

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Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

combine Pegaz and McCormack since the functionality of Pegaz's liquid impermeable outer layer may be lost with use of the McCormack outer nonwoven layer.

Page 6 of 7

Appl. No. 10/027,295  
Atty. Docket No. 6823D  
Amdt. dated Aug. 5, 2005  
Reply to Office Action of May 11, 2005  
Customer No. 27752

Conclusion

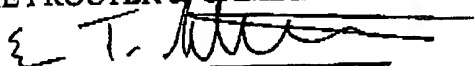
In light of the above remarks, it is requested that the Office reconsider and withdraw the rejections under 35 U.S.C. §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application and allowance of Claims 1-6 is respectfully requested.

Respectfully submitted,

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